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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,656	09/09/2003	Tsuneyoshi Saitoh	58011US004	1992
32692	7590	09/07/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			ZACHARIA, RAMSEY E	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,656	<b>Applicant(s)</b> SAITOH, TSUNEYOSHI	
	<b>Examiner</b> Ramsey Zacharia	<b>Art Unit</b> 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/29/03; 2/19/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3, drawn to an article, classified in class 428, subclass 421.

II. Claim 4, drawn to a method, classified in class 156, subclass 247.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product, such as one in which the water-repellent layer does not contain a fluorocarbon-based polymer binder and/or a fluorocarbon-based resin powder.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with James D. Christoff on 23 August 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-3. Affirmation of this election must be made by applicant in replying to this Office action. Claim 4 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

6. Reference JP 10-88061 in the Information Disclosure Statement filed 29 December 2003 has been crossed out because a copy of the reference was not provide as required by 37 CFR 1.98(a)(2). It is noted that a copy of reference JP 64-88061, directed to a control device for freezer cycle, was provided but not cited in any form PTO-1449. It appears that the applicant intended to make JP 10-88061 of record but mistakenly submitted JP 64-88061. Therefore, the Examiner has cited the English abstract of JP 10-88061 on form PTO-892 to make the reference part of the record.

***Claim Rejections - 35 USC § 102 / 103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schramm (U.S. Patent 3,859,120).

In the embodiment of Example 3, a coating composition comprising fluorocarbon-based polymer binder (Fluoropolymer B) mixed with a fluorocarbon polymer dispersion is applied to a substrate (column 6, line 59-column 7, line 40). Since this coating is composed of the same materials as the water-repellent layer of the instant claims, it should inherently prevent snow adhesion.

The article of Schramm does not comprise a protective layer as recited in instant claim 1. However, the article of claim 3 is formed by removing the claimed protective layer, therefore, the invention of claim 3 also does not comprise a protective layer.

The limitation that the sheet of claim 3 is formed by removing a protective layer is a product-by-process type of limitation. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable.

even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and MPEP § 2113. In this case, the article of Schramm appears to be the same as that of instant claim 3 since the coating layer contains all the structural limitations of the instant water-repellent layer. Therefore, the burden is on the application to conclusively demonstrate that the article of claim 3 is materially different from that of Schramm.

### ***Claim Rejections - 35 USC § 103***

10. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spain et al. (U.S. Patent 5,203,941) in view of Schramm (U.S. Patent 3,859,120).

Spain et al. is directed to a weatherable plastic siding panel (column 1, lines 11-19). The panel comprises a top coat, print coat layers, and an extruded film (Figure 5). The print coat layers and/or extruded film read on the base layer of the instant claims. The top coat is formed by coating an outdoor weatherable protective clear coat, preferably a blend of an acrylic polymer and polyvinylidene fluoride, onto matte release coat and carrier film (column 6, lines 6-37). The matte release coat and/or carrier film read on the protective film of the instant claims. The matte release coat and carrier film are stripped from the top coat to form the finished panel (column 3, lines 20-40).

Spain et al. do not teach the presence of a fluorocarbon-based resin powder in the top coat composition. However, the composition is taught to comprise a clear and weatherable blend of an acrylic polymer and polyvinylidene fluoride.

Schramm is directed to a clear coating composition containing fluorocarbon polymer particles (column 1, lines 10-13). The coating further comprises a binder component that may be

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a blend of an acrylic polymer and a vinylidene fluoride containing polymer (column 1, lines 52-64). The combination of particles and binder yields a finish having excellent weatherability and will not crack, craze, chip or peel even after long periods of outdoor exposure (column 2, lines 19-28).


One skilled in the art would be motivated to use the coating composition of Schramm to form the top coat of Spain et al. because it has excellent weatherability and will not crack, craze, chip or peel even after long periods of outdoor exposure.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Ramsey Zacharia**  
Primary Examiner  
Tech Center 1700